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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,462	06/18/1999	ROLF STEIGER	ICH-286	7675

25230 7590 10/18/2005

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/336,462

Applicant(s)

STEIGER, ROLF

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 8, 9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8, 9, and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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1. Claims 1-3, 5, 8, 9, 11-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brugger et al (6,156,419) in view of Malhotra (5589277) for reasons of record and for reasons given below.

Malhotra teaches the inclusion of an additive hydroxy acid, including aliphatic hydroxycarboxylic acids, in an ink jet recording medium to obtain a medium that has rapid ink drying times, that enables precipitation of a dye from the ink, that is useful in a process including microwave drying and that exhibits reduced curl subsequent to being imaged. It would have been obvious to one of ordinary skill in the art to utilize such an additive in the recording layer of the medium of the primary reference in order to obtain the advantages set forth above.

2. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brugger in view of Malhotra as applied to claims 1-3, 5, 8, 9, 11-19 and 21 above, and further in view of Floegel et al. (US 6284339), Uemura et al. (US 6153305) or Kasahara et al. (6,165,606) for reasons of record.

3. Applicant's arguments filed January 14, 2004 have been fully considered but they are not persuasive. First, it is believed that applicants may not rely on common ownership of the Brugger et al. reference to overcome the 103(a) rejection in this case because this application is an RCE of an application filed prior to November 29, 1999. See MPEP 706(I)(1). The examiner's position with respect to the combination rejection is maintained. The reasons for modifying the primary reference are provided by the secondary reference. It is unclear why one of ordinary skill in the art would not find the teachings of the secondary reference applicable to an ink receiving layer "such as that

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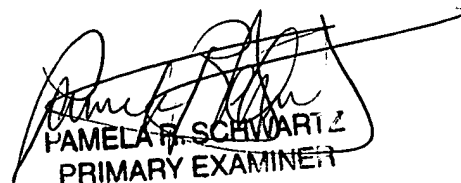
of Brugger" and applicants have provided no reason why one of ordinary skill in the art would not find the teachings of Malhotra to be relevant. The motivation to combine does not have to be found in the primary reference as applicants suggest. Finally, the additive containing layer of Malhotra must also contain binder and may also contain biocide, antistatic agent and filler and the additive may only be present a .8 grams per square meter on the surface of the substrate (see claim 1). Therefore, applicants portrayal of the additive as the being the ink receiving layer of Malhotra is not an accurate portrayal of the full scope of the Malhotra disclosure.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
October 14, 2005



PAMELA R. SCHWARTZ
PRIMARY EXAMINER